

REMARKS

This communication is responsive to the Office Action issued March 5, 2009. In the Action, claims 1-20 were rejected. Claims 1-20 remain pending for the Examiner's consideration.

Claims 1-7 and 11-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Publn. No. 2002/0066113 to Utsunomiya et al. ("Utsunomiya") in view of U.S. Patent No. 6,920,641 to Hanai et al. ("Hanai").

Claim 1 recites "a recordation control process executing section for executing a selection process to select a recording medium based on available capacities of the information recording means."

The Examiner acknowledges that Utsunomiya fails to teach this limitation, but offers Hanai to cure this deficiency. (3/5/09 Office Action, p.4). However, per 35 U.S.C. §103(c), Hanai cannot preclude patentability under 35 U.S.C. §103(a). Particularly, Hanai only qualifies as prior art under §102(e), because it was not published or issued as a patent until July 19, 2005 - subsequent to the February 2, 2005 filing date of the present invention. Moreover, both Hanai and the present application have a common assignee, Sony Corporation, and were under an obligation of assignment to Sony Corporation when the inventions were made. Thus, without reaching the issue of what Hanai teaches, Hanai may not be applied as prior art under §103(a), and thus may not be used to cure the deficiencies of Utsunomiya.

Because Utsunomiya fails to teach "a recordation control process executing section for executing a selection process to select a recording medium based on available capacities of the information recording means," and because Hanai may not be used to cure this deficiency, Applicants respectfully submit that claim 1 is patentable. Accordingly,

Applicants respectfully request that the rejection of claim 1 be withdrawn.

Independent claim 11 recites similar limitations to those of claim 1, and was rejected on the same grounds as claim 1. Accordingly, for at least the reasons discussed above in connection with claim 1, Applicants respectfully submit that claim 11 is patentable and request that its rejection be withdrawn.

Claims 2-7 and 12-17 depend from and therefore include the limitations of claims 1 and 11, respectively. Thus, for at least the reasons discussed above in connection with claims 1 and 11, Applicants respectfully submit that claims 2-7 and 12-17 are also patentable, and request that their rejections be withdrawn.

Claims 8-10 and 18-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Utsunomiya in view of U.S. Patent No. 6,502,164 to Choi et al. ("Choi").

Claim 8 recites that "each of the plurality of information recording means stores management information about content recorded on at least one different recording medium." The Examiner acknowledges that Utsunomiya fails to teach this limitation, but offers Choi to cure this deficiency. (3/5/09 Office Action, p.7). However, Choi also fails to teach this limitation.

Choi discloses a method of transmitting data recorded on a recording medium, wherein a buffer memory of the recording medium is segmented into a first memory and a second memory, and the first memory stores file system data. (Choi, col.4 ll.5-8). Thus, when a connected device requests the file system data, the data may be read out of the first memory quickly. (Id. at col.4 ll.14-20).

Choi nowhere discloses "each of the plurality of information recording means stores management information about

content recorded on at least one different recording medium" as recited in claim 8. Indeed, Choi does not even teach a plurality of information recording means. At best, Choi merely discloses one information recording means, i.e., the buffer, segmented into two sections. Moreover, Choi certainly does not disclose that each of a plurality of recording means stores management information about content recorded on at least one different recording medium. Choi only teaches that management information about one recording medium may be stored in a segment of that same recording medium's memory. This is neither equivalent nor comparable to the limitations of claim 8.

For at least these reasons, Applicants respectfully submit that claim 8 is patentable over Utsunomiya and Choi, taken alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 8 be withdrawn.

Independent claim 18 recites similar limitations to those of claim 8, and was rejected on the same grounds as claim 8. Therefore, for at least the reasons discussed above in connection with claim 8, Applicants respectfully submit that claim 18 is also patentable and request that its rejection be withdrawn.

Claims 9-10 and 19-20 depend from and therefore include the limitations of claims 8 and 18, respectively. Thus, for at least the reasons discussed above in connection with claims 8 and 18, Applicants respectfully submit that claims 8-10 and 18-20 are also patentable, and request that their rejections be withdrawn.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited. If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that the Examiner telephone Applicants' attorney at (908) 654-

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5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

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Respectfully submitted,

By 

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